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MAILED

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OFFICE OF PETITIONS

In re Application of :
Kari Alitalo :
Application No. 10/774,802 : ON APPLICATION FOR
Filed: February 9, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No. 28967/34891.1 :

This is in response to the Corrected Application for Patent Term Adjustment Under 37 C.F.R. §1.705(b) filed January 28, 2010 (and February 1, 2010). Applicants submit that the correct patent term adjustment to be indicated on the patent is either one thousand seven hundred sixty-nine (1,769) days or one thousand six hundred seventy-five (1, 675) days. Applicants request this correction in part on the basis that the Office will take in excess of three years to issue this patent.

Applicants also maintain that the "A" delay pursuant to 37 CFR 1.702(a)(1), associated with the filing of a first Office action, should be calculated as 590 days, not 496 days.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not

undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of mailing of the notice

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

of allowance, the application for patent term adjustment is **DISMISSED**.

Applicants maintain that the Office delay pursuant to 37 CFR 1.702(a)(1) is 590 days, not 496 days. Applicants contend that as the restriction requirement mailed August 18, 2006 was withdrawn on petition by applicant its mailing should not be used to calculate this delay. Rather, applicants state that the calculation should be based on the Office action of November 20, 2006, mailed 14 months and 590 days after the filing date of this application.

Applicants states that the above-identified application is not subject to a terminal disclaimer.

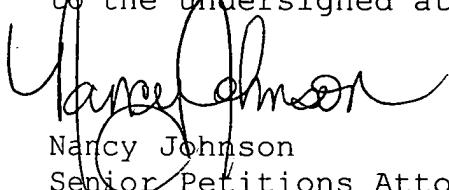
Applicants' argument has been considered, but not found persuasive. A notification under 35 U.S.C. 132 was mailed on August 18, 2006. On October 17, 2006, applicants filed a response to the restriction requirement. In response thereto, on November 20, 2006, the Office mailed a further Office action. On March 23, 2007 applicants filed a petition for withdrawal of the restriction requirement along with a response to the November 20, 2006 Office action. By decision mailed May 23, 2007, the petition was granted and the application was returned to the examiner for consideration of the response filed March 23, 2007 and action consistent with the decision, which rejoined certain claims. The decision did not expressly withdraw or vacate the Office action of August 18, 2006. The mailing of the decision on petition granting certain relief does not negate the fact that the Office took action in this application within the meaning of § 1.702(a)(1) on August 18, 2006. Accordingly, changing of the period of adjustment to 590 days for Office delay based on the mailing of the second Office action is not warranted.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent will include any additional patent term adjustment accrued for Office delay in issuing the patent after payment of the issue fee and all outstanding requirements having been met.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



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